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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/399,083	09/17/99	CALDERWOOD	DDC 043742

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RICHARD W WAGNER  
HAMILTON BROOK SMITH & REYNOLDS  
TWO MILITIA DRIVE  
LEXINGTON MA 02421-4799

EXAMINER

ART UNIT  
1624

PAPER NUMBER

DATE MAILED:

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11/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/399,083

Applicant(s)

Calderwood et al.

Examiner

D. Pak Ra

Group Art Unit

1624



☒ Responsive to communication(s) filed on Sep 28, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-8 and 10-48 ☒ are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 and 10-48 ☒ are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9 & 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

This office action is in response to the amendment filed on September 28, 2000.

Claims 1-8 and 10-48 are pending in this application.

***The following rejections are withdrawn:***

The rejections under 35 U.S.C. 112, first and second paragraph of the previous office action are hereby withdrawn in view of applicant's amendments and remarks.

The rejection under 35 U.S.C. 103(a) over Missbach et al., WO 96/10028 is withdrawn as the instantly claimed compounds are deemed to be not suggested by the reference.

***The following rejections are maintained:***

1. Claims 1-8, 10-45 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Calderwood et al., U.S. Patent No. 6,001,839, for the reasons provided in the previous office action which are incorporated herein by reference. Applicant's citation of *Applied Materials Inc. v. Gemini Research Corp.*, 15 USPQ2d 1816 (CAFC 1988) and the arguments are fully considered, but they were not deemed to be persuasive. In the cited case it was concluded that "[t]he applications which matured into the '712 and '313 patents grew from the same original application and the invention claimed in the '313 patent was **fully disclosed** in the '712 patent". This is not the situation in the instant case, the instantly claimed invention is not fully disclosed (i.e., the instant invention does not fully meet the description requirements of 35 U.S.C. 112, first

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paragraph) in the reference US'839 and therefore, the instant claims are not eligible for benefit of the filing date of US'839 and are only eligible for the filing date of September 17, 1999. See MPEP § 2133.01. US'839 resulted from an earlier filed application having an effective filing date March 19, 1997, and therefore, available as a reference for the instant application. The reference expressly teaches compounds that fall within the instantly claimed genus, see the compounds in col. 7-10, and therefore, the rejection under 35 U.S.C. 102(e) is proper and maintained.

2. Claims 1-8 and 10-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calderwood et al., U.S. Patent No. 6,001,839, for the reasons provided in the previous office action which are incorporated herein by reference. The reference teaches a generic group of compounds and expressly teaches species that fall within the instantly claimed genus according to claims 1-8, 10-45 and 47, see the rejection under 35 U.S.C. 102. The species of claim 46 are also clearly suggested in the reference. The reference clearly teaches that the phenyl ring in formula (a) is an optionally substituted phenyl and further, expressly provides a group from which the substituents are selected, e.g., alkyl, alkoxy, halo etc., see col. 3. Furthermore, the reference discloses examples wherein the phenyl group is substituted by one of the substituents recited in the group of substituents, see col. 10, lines 5-6, wherein the species has a 2-methoxyphenyl group. The instantly claimed species of claim 46 differs only by changing the substituent with another substituent which is also taught in the reference, see e.g., the sixth species in claim 46 contains a 2-chlorophenyl, however, the reference clearly teaches the optional substituents to be chosen from alkoxy, halo, etc. Similarly, see compound in col. 10, lines 13-14, which shows the phenyl ring in

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R<sub>3</sub> as well as the phenyl ring of R<sub>5</sub> having a substituent, which is similar to the instantly claimed species of claim 46, see e.g., the second species. Therefore, the reference clearly teaches the instantly claimed compounds and therefore, one of ordinary skill in the art would have been motivated to modify the reference compounds to prepare the instantly claimed compounds.

3. Claims 1-8 and 10-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,001,839, for the reasons provided in the previous office action, which are incorporated herein by reference. Applicant's argument that the 'instant invention is not fully disclosed in and covered by claims 1-27 of the reference', is fully considered but not deemed to be persuasive. The instantly claimed invention overlaps the invention claimed and issued in US'839, and two patents can not be issued for the same or overlapping subject matter.

***The following rejections are necessitated by the amendment:***

***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-45, 47 and 48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The definition of L in claim 1 was amended to include  $\text{-NHC(O)R}_{130}\text{-}$  and  $\text{-NHSO}_2\text{R}_{130}\text{-}$  wherein  $\text{R}_{130}$  is an aliphatic group, however, this definition of L is not described in the specification within the genus. Applicant referred to Examples 185-187 (page 174) and 290-294 (pages 205-208) in the specification wherein the species contain a  $\text{-NH-SO}_2\text{-CH}_2\text{-}$ ,  $\text{-NH-C(O)-CH}_2\text{-}$  or  $\text{-NH-SO}_2\text{-CH=CH-}$  groups in place of  $\text{-L-(CH}_2\text{)}_j\text{-}$  of the genus, as support for the instant amendment. First, the  $\text{-CH}_2\text{-}$  portion of the above groups may be representative of  $\text{-(CH}_2\text{)}_j\text{-}$  which separates L and  $\text{R}_3$  in the generic structural formula. Secondly, examples having  $\text{-CH}_2\text{-}$  or  $\text{-CH=CH-}$  are not sufficient to form support for the broad term "aliphatic group" which can include carbon chain having any number of carbon atoms. Further, these definitions ( $\text{-CH}_2\text{-}$  or  $\text{-CH=CH-}$ ) are disclosed as being only part of the specific compounds and are not disclosed to be part of the genus. Therefore, there is no support in the specification for the addition of the  $\text{R}_{130}$  variable defined to be an "aliphatic group", to the generic claims or for the introduction of the L values of  $\text{-NHSO}_2\text{CH}_2\text{-}$ ,  $\text{-NHC(O)CH}_2\text{-}$  or  $\text{-NHSO}_2\text{CH=CH-}$  to the entire genus. This moiety is not described within the genus of the structural formula and the myriad of permutations that are present within the genus do not include all of the permutations possible of adding the instant L, and thus, the genus may result in species that were not contemplated. Further, written description of species would not support claims to the generic element. "Disclosure of Two species in prior

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application did not provide written description to generic claims added in CIP", see *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998).

Receipt is acknowledged of the Information Disclosure Statements filed on June 12, 2000 and October 10, 2000 and copies are enclosed herewith.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The fax phone

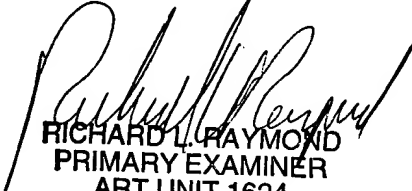
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number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Deepak Rao   
November 9, 2000

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624